

REMARKS

Claims 25-35 and 39-41 constitute the pending claims in the present application. Various issues not common to a Restriction Requirement are raised by the Examiner and are addressed below in the order they appear in the prior Office Action.

1. Noting of Informalities

The Office Action takes issue with several “informalities” in the substitute specification as filed. These are addressed individually below.

2. Numbering of Claims

Applicants acknowledge the Office’s request that the “original” numbering of claims be preserved. Applicants note, however, that pursuant to MPEP 1121:

To avoid submitting preliminary amendments, applicants should incorporate any desired amendments into the text of the specification *including a new set of claims*, even where the application is a continuation or divisional application, a new specification (e.g., reflecting amendments made in the parent application) may be submitted together with a copy of the oath or declaration from the previously filed application. See 37 CFR 1.63(d)(1)(iii).

(emphasis added). Indeed, Applicants previously submitted a substitute specification, including a marked-up copy to facilitate the Office’s consideration, yet the substitute specification seems not to have been entered in place of the specification filed in the parent case. The Office makes reference to 37 CFR 1.126: “When claims are cancelled the remaining claims must not be renumbered.” However, the cited CFR section does not apply, since “original” claims 1-24, for example, should have never been entered since they were not part of the substitute specification. Rather claims 1-14 (now renumbered as claims 25-35 and 39-41) should have been entered as the “original” claims.

Nevertheless, in order to expedite prosecution, Applicants are complying with the Examiner’s suggestion in renumbering the currently pending claims. Applicants also comply with the Examiner’s request that changes made to the claims from the parent application be reflected in the form of amendments to the claims, including claim identifiers. However, claims 39-40 are designated properly as “previously presented” rather than “new.” This designation facilitates Applicants further amendment and cancellation of the claims originally presented.

3. Declaration

Applicants note that the Examiner has requested a new Declaration indicating that “Applicants have reviewed and understand the subject matter of the preliminary amendment filed December 12, 2003.” However, Applicants request clarification from the Examiner and highlight that no preliminary amendment has been made of record. Rather a substitute specification with marked-up version and an original specification were filed on December 12, 2003.

Regarding the Office’s request for a new Declaration, Applicants respectfully point out that pursuant to MPEP 602.05(a):

A copy of the oath or declaration from a prior non-provisional application may be filed in a continuation or divisional application *even if* the specification for the continuation or divisional application *is different* from that of the prior application, in that revisions have been made...to make...changes provided the changes do not constitute new matter relative to the prior application. See 37 CFR 1.52(c)(3).

(emphasis added). Applicants assert that the changes made in the instant application relative to the parent application do not constitute new matter. The Office has not made of record that the instant application contains new matter relative to the parent case, nor indicated that the present application should be re-designated as a continuation-in-part. If the Office does assert new matter has been added, Applicants request clarification on which portions of the instant application to which this would pertain. Otherwise, Applicants assert that the Declaration of record is sufficient and in full compliance with the rules.

4. Support for Claimed Subject Matter

Although Applicants have made of record that changes to claims 25-34 and 39-41 are not “amendments” made during prosecution, for the purpose of advancing prosecution, Applicants list the support for these changes. Support for claim 25 can be found in the specification at least in the paragraph beginning on page 8, line 32. Support for claim 39 can be found in the specification at least in the paragraph beginning on page 50, line 4. Support for claim 40 can be found in the specification at least on page 54, line 18. Support for claim 41 can be found in the specification at least on page 54, line 20.

5. Current Status of Related Applications

Applicants acknowledge the Office's request to update the status of the parent applications in the specification. The specification is amended to reflect the updated status of these documents.

6. Restriction Requirement

Applicants hereby elect, for search purposes only, claim 40, drawn to a "method for treating or preventing stroke, comprising administering a composition including a cAMP antagonist to a patient," with traverse. Applicants assert that a search of the substance of claims 35, 40, and 41 will not present an undue burden on the Office. In particular, the Office has acknowledged that claims 35, 40, and 41 are linked by claims 25-34, and, as such, are species claims falling within the broader genus of the linking claims. Hence, a search of the genus of linking claims 25-34 will necessarily encompass a search for species claims 35, 40, and 41, and will not present an undue burden on the Office.

While the Office contends that the inventions of Groups I-II and species i-vi are unrelated since the inventions "are not disclosed as being capable of use together," Applicants do not agree that Groups I-II and species i-vi are unrelated and respectfully highlight that in conformity with MPEP 803 "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to independent or distinct inventions*" (emphasis added). As noted above, a search of claims 35, 40, and 41 with claims 25-34 will not present an undue burden on the Office, so the Restriction Requirement is improper.

In any event, as the Office has acknowledged, upon allowance of the linking claims, the Restriction Requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application (MPEP 809).

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

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Respectfully Submitted,



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